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EXAMINER

JOLLEY, KIRSTEN

ART UNIT

PAPER NUMBER

1762

DATE MAILED: 09/25/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/021,212

Applicant(s)

ARNDT, DOUGLAS C.

Examiner

Kirsten C Jolley

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-- The MAILING DATE of this communication appears on the cover sheet with the corresponding address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) 22-26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9, 13-19, 21 is/are rejected.
- 7) ☒ Claim(s) 10-12 and 20 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## DETAILED ACTION

### *Election/Restriction*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-21, drawn to an inkless fingerprint composition and disposable applicator and method of making, classified in class 428, subclass 101 and class 427, subclass 1.
  - II. Claims 22-26, drawn to a method of making a nonstaining fingerprint composition and disposable applicator, classified in class 427, subclass 1.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions use different fingerprint compositions and therefore are not disclosed as capable of use together, have different modes of operation, and different effects.
3. Because these inventions are distinct for the reasons given above and the search required for Group II is not required for Group I, restriction for examination purposes as indicated is proper.
4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

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5. During a telephone conversation with Harold Jackson on September 19, 2003 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-21. Affirmation of this election must be made by applicant in replying to this Office action. Claims 22-26 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

### *Specification*

6. The disclosure is objected to because of the following informalities:

On page 2, line 20, the word "lest" appears to be a typographical error.

The use of the trademark "Mylar" has been noted on pages 5 and 11 in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology. Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

On page 6, line 28, it appears that the word "transaction" should be --transition--.

On page 9, line 20, it appears that the word "a" should be --at--.

Appropriate correction is required.

### *Claim Objections*

7. Claims 5-8 and 13-21 are objected to because of the following informalities:

In claim 5, line 3, it appears that "n" should be --in--.

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Claim 5 states “wherein the color former comprises one or more metal salts selected from the groups listed n [sic] the periodic table under columns ...”, however it is noted that the metal *salts* are not listed in the periodic table, but rather the metals of the metal salts. The language of claim 5 should be corrected to indicate that the metals of the metal salts are selected from the listed groups of the periodic table.

Claim 6 states “wherein the color former is selected from one or more of the following transition metal salts: ferric chloride, titanium, vanadium, ...” It is noted that, with the exception of ferric chloride, the compounds listed are not metal salts, but are just metals. The language of claim 6 should be corrected to indicate that the *metals* of the metal salts are selected from the listed group.

In claim 7, line 1, there is no antecedent basis for “the solvent”. For the purpose of examination, claims 7-8 have been interpreted as requiring a solvent in the inkless fingerprint composition of claim 1.

In claim 8, lines 7-8, it is noted that it is improper U.S. practice to incorporate parenthetical limitations in the claims.

In claim 13, line 1, it appears that “inless” should be --inkless--.

In claim 15, line 3, it appears that “n” should be --in--.

Claim 15 states “wherein the color former comprises one or more metal salts selected from the groups listed n [sic] the periodic table under columns ...”, however it is noted that the metal *salts* are not listed in the periodic table, but rather the metals of the metal salts. The language of claim 15 should be corrected to indicate that the metals of the metal salts are selected from the listed groups of the periodic table.

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Claim 16 states “wherein the color former is selected from one or more of the following transition metal salts: ferric chloride, titanium, vanadium, ...” It is noted that, with the exception of ferric chloride, the compounds listed are not metal salts, but are just metals. The language of claim 16 should be corrected to indicate that the *metals* of the metal salts are selected from the listed group.

In claim 17, line 1, there is no antecedent basis for “the solvent”. For the purpose of examination, claims 17-18 have been interpreted as requiring a solvent in the inkless fingerprint composition of claim 1.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claim 14 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 14 contains the trademark/trade name “Mylar.” Where a trademark/trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 USC 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a

trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe a plastic strip and, accordingly, the identification/description is indefinite. See MPEP 2173.05(u).

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1-2, 13-14, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Leavitt et al. (US 4,363,286) in view of Meadows et al. (US 4,699,077), and further in view of Smith, III et al. (US 4,182,261) or Streeter et al. (US 5,879,453).

With respect to claims 1 and 13, Leavitt et al. discloses a disposable applicator having an inkless fingerprint composition thereon, the applicator comprising: first and second substantially nonpermeable foil strips having substantially the same width, with the first strip being slightly longer than the second strip to provide an extended pull-tab when the strips are superimposed on one another (see Figure 1), and an inkless fingerprint composition thereon. It is known that the fingerprint composition is inkless because Leavitt et al. states in col. 1, lines 49-51, that the bottom sheet 11 has an inked top surface 12 for the placement of a person's fingers 13 to obtain clear fingerprints 14.

Leavitt et al. lacks a teaching of leaving a border around the perimeter of the strips without the inkless fingerprint composition. Meadows et al. is cited for its teaching of a

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disposable applicator comprising an inkless fingerprint composition therein, whereby a perimeter of the foil strips has been left without fingerprint composition (col. 4, lines 18-23). Meadows et al. states that the perimeter has been left uncoated to allow for seam lines displaced inward from the outer edges, leaving a set of lips which can be gripped to part the side seams. It would have been obvious for one having ordinary skill in the art, upon seeing the reference of Meadows et al., to have modified the packet of Leavitt et al. by leaving the perimeter of its foil strips uncoated and providing side seams therein in order to prevent contamination of the ink inside Leavitt et al.'s packet, to protect Leavitt et al.'s packet from opening unintentionally, and to provide easier opening of the packet to the user.

Leavitt et al. is silent with regard to the composition of the inkless fingerprint composition which is provided thereon. One having ordinary skill in the art would have been motivated to look to the prior art for an exemplary inkless fingerprint composition which is capable of being provided directly on a foil strip substrate, without being so liquid that it runs off the bottom strip as soon as the top strip of Leavitt et al.'s packet is opened.

Smith, III et al. discloses a first inkless fingerprint composition (liquid developer solution) having a viscosity of 200-400 cps. Smith, III et al.'s developer solution has a thickness sufficient to prevent penetration into the substrate and to produce a coating of fingerprint composition on the user's finger such that an adequate fingerprint print can be formed (col. 7, lines 50-56 and col. 9, lines 65-69). It is the Examiner's position that an inkless fingerprint/developer solution having the disclosed viscosity of up to 400 cps meets the claim limitation of a "semi-solid." Alternatively, Streeter et al. is cited for its teaching of using a preferred inkless fingerprint composition which is a clear, non-toxic organic gel inkless



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fingerprint material (col. 6, lines 38-42). It would have been obvious for one having ordinary skill in the art to have used the thick or gel inkless fingerprint compositions taught by Smith, III et al. or Streeter et al. as the clear fingerprint composition in the packet of Leavitt et al. with the expectation of successful results because Leavitt et al. is not limited as to fingerprint compositions that may be used in its invention, and because the compositions of Smith, III et al. and Streeter et al. are substantially thick that they will not run off the bottom foil strip surface as soon as the packet of Leavitt et al. is opened.

As to claims 2 and 21, Meadows et al. teaches leaving a border of 1/16 to 1/4 inch in width. As to claim 14, Leavitt et al. is silent with regard to the material of its foil strips or their thickness. Meadows et al. teaches that the foil may have an outer surface of a tougher resin such as Mylar to provide resistance to wrinkling or cracking and to provide a surface for imprinting product name or instructions (col. 3, lines 64-68). It would have been obvious for one having ordinary skill in the art to have incorporated a Mylar outer layer to the foil strips of Leavitt et al., upon seeing the teachings of Meadows et al., in order to provide wrinkling and cracking resistance to the packet and to print product name and/or instructions thereon. As to the thickness of the Mylar layer, one skilled in the art would have been motivated to minimize the thickness for economic reasons, however also to have determined a thickness that is sufficient to provide wrinkling and cracking resistance and is strong enough to enable printing thereon. It is well settled that determination of optimum values of cause effective variables such as this process parameter is within the skill of one practicing in the art. *In re Boesch*, 205 USPQ 215 (CCPA 1980).

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12. Claims 3-7, 9, 15-17, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Leavitt et al. (US 4,363,286) in view of Meadows et al. (US 4,699,077), and further in view of Smith, III et al. (US 4,182,261).

Leavitt et al. is applied in view of Meadows et al. and Smith, III et al. for the reasons discussed above in section 11.

With respect to claims 4, 7, 17, Smith, III et al. teaches that the solvent/carrier medium is compatible with the color former and comprises glycerine and/or ethylene glycol (col. 6, lines 47-52). With respect to claims 5-6 and 15-16, Smith, III et al. teaches that the color former is ferric chloride (col. 8, lines 33-43).

As to claims 9 and 19, the developer composition of Smith, III et al. is inherently in a liquid phase at a temperature of 110 F and above because the claimed temperatures are above the melting points of Smith, III et al.'s carrier medium.

As to claim 3, Smith, III et al. does not teach that its inkless composition is heated prior to applying it to a substrate surface. However, the Examiner notes that it is well known in the coating art to heat a coating composition to decrease its viscosity to ease application onto a substrate surface. It would have been obvious for one having ordinary skill in the art to have heated Smith, III et al.'s inkless fingerprint composition prior to application on the bottom foil strip of Leavitt et al. in order to easily apply the viscous coating onto the substrate surface in a uniform manner, without rubbing or having the viscous coating material stick to its applicator instead of the substrate surface thereby forming a non-uniform coating, for example.

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13. Claims 8 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Leavitt et al. in view of Meadows et al. and Smith, III et al. as applied to claims 7 and 17 above, and further in view of Arndt (US 5,919,292).

Leavitt et al. is applied in view of Meadows et al. and Smith, III et al. for the reasons discussed in sections 11 and 12 above. The inkless fingerprint composition of Smith, III et al. lacks a teaching of using the claimed solvents of claims 8 and 18.

Arndt is cited as being directed to a fingerprint ink composition which, similar to Smith, III et al., desires a non-volatile, viscous carrier medium (col. 3, line 51 to col. 4, line 33). Arndt discloses the use of non-volatile oils, non-volatile oil complexes, fatty alcohols, and fatty acid esters as the carrier medium, including the use of glyceryl monooleate. It would have been obvious for one having ordinary skill in the art to have substituted one of the non-volatile carriers of Arndt, including glyceryl monooleate, as the non-volatile carrier in the inkless fingerprint composition of Smith, III et al. because Arndt teaches successful use of the carriers in non-toxic, organic fingerprint compositions to produce a viscous fingerprint material, as is similarly desired by Smith, III et al.

#### *Allowable Subject Matter*

14. Claims 10-12 and 20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims and written to overcome the claim objections. As to claims 10 and 20, the prior art does not teach or fairly suggest the use of an inkless fingerprint composition in a semi-solid state which includes both a color former and a developer and a sufficient amount

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of chelating agent capable of binding with the color former to substantially prevent the color former and developer from reacting in solution while permitting such reaction when the solution is applied to a person's fingerprint area and deposited onto a paper substrate, particularly in combination with the disposable applicator of claims 1 and 13. Claims 11-12 are allowable because they further depend from claim 10.

### *Conclusion*

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Picard (US 3,089,459) and Arndt (US 6,027,556) are cited for their teachings of disposable applicators similar to the claimed disposable applicator.

Arndt (US 6,488,750) is cited for its teaching of a composition comprising both a color former and developer in combination with a chelating agent, as claimed in claims 10-12 and 20, however the reference does not qualify as prior art under 35 USC 102(e).

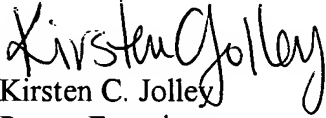
Mason, Jr. et al. (US 5,143,551), Reardon (US 5,078,426), Koch (US 5,263,742), and Arndt (US 5,737,071) are cited to illustrate the state of the prior art with respect to the instant claims.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kirsten C Jolley whose telephone number is 703-306-5461. The examiner can normally be reached on Monday to Thursday and every other Friday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive Beck can be reached on 703-308-2333. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1193.

  
Kirsten C. Jolley  
Patent Examiner  
Technology Center 1700

kcj